

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE DIVISION

IMPOSSIBLE FOODS INC.,

Plaintiff,

v.

IMPOSSIBLE X LLC, et al.,

Defendants.

Case No. 5:21-cv-02419-BLF

**ORDER GRANTING-IN-PART AND
DENYING-IN-PART PLAINTIFF'S
MOTION FOR PARTIAL SUMMARY
JUDGMENT AND DENYING
DEFENDANTS' MOTION FOR
PARTIAL SUMMARY JUDGMENT**

[Re: ECF Nos. 259, 262]

This is an action for trademark infringement and unfair competition arising from the Parties' use of marks involving the word "IMPOSSIBLE" in connection with their goods and services. Plaintiff/Counter-Defendant Impossible Foods Inc. ("Impossible") and Defendants/Counter-Plaintiffs Impossible X LLC and Joel Runyon (collectively, "IX") each move for partial summary judgment, raising separate issues.

Impossible moves for partial summary judgment that (1) IX is not entitled to damages for any of its counterclaims and (2) IX's affirmative defenses to Impossible's claims fail as a matter of law. ECF No. 259 ("Pl.'s Mot."); *see also* ECF No. 282 ("Pl.'s Reply"). IX opposes the motion. *See* ECF No. 277 ("Defs.' Opp.").

IX moves for partial summary judgment that (1) Impossible's Lanham Act claims are factually and legally deficient; (2) Impossible's common-law unfair competition claim fails as a matter of law; (3) IX's marks cannot be declared void for fraud on the United States Patent and Trademark Office ("PTO"); (4) IX's marks have not been abandoned; and (5) IX is entitled to summary adjudication of priority as to certain marks. ECF No. 262 ("Defs.' Mot."); *see also* ECF No. 287 ("Defs.' Reply"). Impossible opposes the motion. *See* ECF No. 274 ("Pl.'s Opp.").

The Court held a hearing on the Parties’ motions on October 23, 2025. ECF No. 306. For the reasons set forth below, the Court GRANTS-IN-PART and DENIES-IN-PART Impossible’s motion for partial summary judgment and DENIES IX’s motion for partial summary judgment.

I. BACKGROUND

A. The Parties and Their Marks

Impossible develops, markets, and sells plant-based substitutes for meat products. *See* Declaration of Caitlyn Hatman (“Hatman Decl.”) ¶¶ 2–3, ECF No. 259-22. Operating since 2011 under various names, including “Maraxi,” Impossible adopted its current name and IMPOSSIBLE mark in 2015. *Id.* ¶¶ 4–5. Impossible released its signature product—the Impossible Burger—in July 2016, and the Impossible Burger is now available in grocery stores and restaurants across the country. *Id.* ¶¶ 6–8. Impossible has since expanded to other food products and services, including the Impossible Sausage, Impossible Pork, and Impossible Taste Place. *Id.* ¶¶ 9–11. Impossible also sells a cookbook (the “Impossible Cookbook”) and offers IMPOSSIBLE-branded clothing to consumers for promotional purposes (“Impossible Swag”). *See* Declaration of R. Charles Henn Jr. (“Henn Decl.”) Ex. G (“Palmatier Rep.”) ¶¶ 43–44, ECF No. 259-1; Henn Decl. Ex. Q.

Impossible owns various IMPOSSIBLE and IMPOSSIBLE-formative federal trademark registrations, including U.S. Trademark Reg. No. 5,370,337, first use in commerce November 3, 2016 (“[p]roviding of food and drink via mobile truck; catering services”), and U.S. Reg. No. 5,459,255, first use in commerce June 27, 2016 (“[s]ubstitutes for foods made from animals or animal products, namely, vegetable-based burger patties; meat substitutes”). *See* Henn Decl. Ex. R at 12. Impossible also alleges that it holds common-law rights to the presentation of the IMPOSSIBLE mark depicted below, which it began to use as early as 2016:



IMPOSSIBLE

1 ECF No. 1.¹

2 Mr. Runyon is an entrepreneur, blogger, and fitness enthusiast and the sole member,
3 owner, and employee of Impossible X LLC. Declaration of Greg Washington (“Washington
4 Decl.”) Ex. A at 2, ECF No. 262-1. According to Mr. Runyon, his use of the word “impossible”
5 came to him in 2010, when he had the idea to create a personal “Impossible List” of things that
6 might seem impossible at first but could be accomplished with hard work. Washington Decl.
7 Ex. B (“Runyon Dep. Tr.”) at 103:4–14. From that idea, Mr. Runyon created the “Blog of
8 Impossible Things” to encourage readers to “Do the Impossible.” *Id.* at 104:10–105:8; *see also*
9 Washington Decl. Ex. A. Since launching his blog, Mr. Runyon has expanded to numerous other
10 ventures—including search engine optimization, social media influencing, and fitness and dieting
11 advice—using IX as the business vehicle for his Impossible-centered offerings. Through IX,
12 Mr. Runyon also sells certain clothing products, as well as sleep powders and energy powders (the
13 “IX Powders”). *See* Runyon Dep. Tr. at 64:9–14, 145:6–9.

14 IX also owns various federal trademark registrations using the word IMPOSSIBLE. *See*
15 Washington Decl. Exs. O–Y. As relevant here, these include a word mark and motion mark for
16 IMPOSSIBLE, respectively U.S. Trademark Reg. No. 5,620,625, first use in commerce
17 September 1, 2011 (“[c]lothing and performance apparel, namely,” “t-shirts, “tank tops”),² and
18 U.S. Trademark Reg. No. 6,571,603, first use in commerce May 29, 2012 (“clothing and
19 performance apparel, namely, t-shirts, sweatshirts, pants, shorts, tank tips, yoga pants, tights and
20 underwear”). IX also owns a word mark and design mark for IMPOSSIBLE FITNESS,
21 respectively U.S. Trademark Reg. No. 5,590,801, first use in commerce January 24, 2014
22 (“[c]lothing and performance apparel, namely, t-shirts, sweatshirts, pants, shorts, tank tops, yoga
23 pants, tights”), and U.S. Trademark Reg. No. 5,603,025, first use in commerce January 24, 2014
24 (“[c]lothing and performance apparel, namely, t-shirts, sweatshirts, pants, shorts, tank tops, yoga
25 pants, tights”). IX’s marks represent the idea of striking items from one’s “Impossible List” by

26
27 ¹ This presentation is substantially similar in appearance to the design covered by many of
Impossible’s federal trademark registrations. *See, e.g.*, U.S. Trademark Reg. No. 7,179,385.

28 ² As described *infra*, IX has amended its IMPOSSIBLE word mark to remove all Class 25 goods
except for t-shirts and tank tops.

depicting a single-line strikethrough of the word IMPOSSIBLE as depicted below:

U.S. Trademark Reg. No. 5,603,025.

B. Trademark Dispute

On April 1, 2020, Impossible filed an application with the PTO for an IMPOSSIBLE word mark for goods and services associated with “[p]roviding information about recipes, ingredients and cooking information; providing an online computer database to consumers featuring information about recipes, ingredients and cooking information.” U.S. Trademark Application Serial No. 88,855,875; *see also* ECF No. 1-2. In response to Impossible’s application, IX sent a demand letter to Impossible on November 10, 2020. Washington Decl. Ex. KK at 1. In its letter, IX asserted that it held superior rights to the IMPOSSIBLE mark and explained that, although it “initially believed that [Impossible’s] use of IMPOSSIBLE solely in connection with plant-based meat substitutes would not be likely to cause confusion, [Impossible’s] recent encroachment into spaces either occupied or closely related to goods and services offered by [IX] greatly increases the likelihood of confusion.” *Id.* at 1–2. IX concluded the letter by demanding that Impossible cease using the IMPOSSIBLE mark in certain contexts (e.g., when not accompanied by FOODS) and limit its use to association with plant-based meat substitutes. *Id.* at 2–3.

Two weeks after sending the demand letter, IX filed a Notice of Opposition to Impossible’s application with the Trademark Trial and Appeal Board. ECF No. 1-3. In its notice, IX asserted that it had “used the IMPOSSIBLE Marks in association with nutrition, food, and cooking resources since 2010 including publication of guides to different foods, ingredients, diets, and recipes.” *Id.* ¶ 2. Impossible initiated this action on April 2, 2021, by filing an initial complaint asserting a single claim for declaratory relief. ECF No. 1. In its complaint, Impossible requested that the Court issue an order declaring that Impossible’s use and registration of IMPOSSIBLE with services related to recipes, food ingredients, and cooking information do not

1 infringe upon IX's rights and that Impossible's rights in IMPOSSIBLE are superior to IX's rights.
2 *Id.* at 7–8. The Parties have since added numerous claims and counterclaims.

3 As relevant here, Impossible has added claims for trademark infringement and unfair
4 competition under the Lanham Act, 15 U.S.C. §§ 1051–1141n, and California common law,
5 alleging that IX's use of its IMPOSSIBLE marks in connection with the marketing and sale of the
6 IX Powders is unlawful. Third Amended Complaint ("TAC") ¶¶ 104–21, ECF No. 151.
7 Impossible also seeks cancellation of IX's IMPOSSIBLE and IMPOSSIBLE FITNESS marks (the
8 "Challenged Marks") pursuant to 15 U.S.C. §§ 1064, 1119, 1127 for fraud and abandonment.
9 Impossible alleges that all four Challenged Marks were procured by fraud and that three of the
10 Challenged Marks (not the IMPOSSIBLE word mark) were abandoned. In its revised answer and
11 counterclaims, IX asserts affirmative defenses of laches, waiver, acquiescence, estoppel, and
12 unclean hands, as well as counterclaims for trademark infringement and unfair competition under
13 the Lanham Act and California common law, alleging that Impossible's use of its IMPOSSIBLE
14 marks in connection with the Impossible Cookbook and Impossible Swag is unlawful. *See*
15 Answer to Third Amended Complaint ("Answer") at 53–54, ECF No. 241; Counterclaims to Third
16 Amended Answer ("Countercls.") ¶¶ 62–78, 89–99, ECF No 241.

17 **II. LEGAL STANDARD**

18 Federal Rule of Civil Procedure 56 governs the standards for both motions for summary
19 judgment and motions for partial summary judgment, which are identical. *See E.piphany, Inc.,*
20 *v. St. Paul Fire & Marine Ins. Co.*, 590 F. Supp. 2d 1244, 1250 (N.D. Cal. 2008). "A party is
21 entitled to summary judgment if the 'movant shows that there is no genuine dispute as to any
22 material fact and the movant is entitled to judgment as a matter of law.'" *City of Pomona v. SQM*
23 *N. Am. Corp.*, 750 F.3d 1036, 1049 (9th Cir. 2014) (quoting Fed. R. Civ. P. 56(a)). A fact is
24 "material" if it "might affect the outcome of the suit under the governing law," and a dispute as to
25 a material fact is "genuine" if there is sufficient evidence for a reasonable trier of fact to decide in
26 favor of the nonmoving party. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986).

27 The moving party bears the initial burden of proving the absence of a genuine issue of
28 material fact. *Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986); *In re Oracle Corp. Sec. Litig.*,

627 F.3d 376, 387 (9th Cir. 2010). To meet its burden, “the moving party must either produce evidence negating an essential element of the nonmoving party’s claim or defense or show that the nonmoving party does not have enough evidence of an essential element to carry its ultimate burden of persuasion at trial.” *Nissan Fire & Marine Ins. Co. v. Fritz Cos.*, 210 F.3d 1099, 1102 (9th Cir. 2000). If the nonmoving party bears the burden of proof at trial, the moving party need only demonstrate that there is an absence of evidence to support the nonmoving party’s case. *Celotex*, 477 U.S. at 325; *see also* Fed. R. Civ. P. 56(c)(1)(B).

“Where the moving party meets that burden, the burden then shifts to the non-moving party to designate specific facts demonstrating the existence of genuine issues for trial.” *In re Oracle*, 627 F.3d at 387. “[T]he non-moving party must come forth with evidence from which a jury could reasonably render a verdict in the non-moving party’s favor.” *Id.* The court must view the evidence in the light most favorable to the nonmovant and draw all reasonable inferences in the nonmovant’s favor. *Clicks Billiards Inc. v. Sixshooters Inc.*, 251 F.3d 1252, 1257 (9th Cir. 2001). “To survive summary judgment, a party does not necessarily have to produce evidence in a form that would be admissible at trial, as long as the party satisfies the requirements of Federal Rule of Civil Procedure 56.” *Block v. City of Los Angeles*, 253 F.3d 410, 418–19 (9th Cir. 2001). “Where the record taken as a whole could not lead a rational trier of fact to find for the nonmoving party, there is no ‘genuine issue for trial.’” *Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 587 (1986) (quoting *First Nat’l Bank of Ariz. v. Cities Serv. Co.*, 391 U.S. 253, 288–89 (1968)).

“Because of the intensely factual nature of trademark disputes, summary judgment is generally disfavored in the trademark arena.” *Am. Auto. Ass’n of N. Cal., Nev. & Utah v. Gen. Motors LLC*, 367 F. Supp. 3d 1072, 1088 (N.D. Cal. 2019) (quoting *Interstellar Starship Servs., Ltd. v. Epix Inc.*, 184 F.3d 1107, 1109 (9th Cir. 1999)); *see also Yuga Labs, Inc. v. Ripps*, 144 F.4th 1137, 1167 (9th Cir. 2025) (collecting cases).

III. IMPOSSIBLE’S MOTION

Impossible does not request partial summary judgment as to any of the Parties’ claims or counterclaims but instead seeks to knock out IX’s demands for damages and its affirmative

defenses.³ The Court finds that Impossible is entitled to partial summary judgment as to IX's demand for reputational damages and its five affirmative defenses, but that triable issues of fact preclude partial summary judgment as to IX's demands for corrective advertising damages and punitive damages.

A. Damages

1. Corrective Advertising Damages

Impossible requests that the Court grant partial summary judgment that IX is not entitled to corrective advertising damages. Impossible argues that IX cannot establish entitlement to corrective advertising damages because it has failed to adduce any evidence that the value of IX's marks was damaged by the Impossible Cookbook and Impossible Swag. Pl.'s Mot. at 4. IX responds that Mr. Runyon's 30(b)(6) deposition testimony, together with the expert opinions of Dr. Palmatier and Dr. Vanderhart, *see* Henn Decl. Ex. H ("Vanderhart Rep."), creates a triable issue of fact as to whether IX's goodwill, reputation, and business have been injured because of Impossible's use of its IMPOSSIBLE marks in connection with the Impossible Cookbook and the Impossible Swag. Defs.' Opp. at 9.

"An award of the cost of corrective advertising, like compensatory damage awards in general, is intended to make the plaintiff whole. It does so by allowing the plaintiff to recover the cost of advertising undertaken to restore the value plaintiff's trademark has lost due to defendant's infringement." *Adray v. Adry-Mart, Inc.*, 76 F.3d 984, 988 (9th Cir. 1995). "Such an award, however, is 'appropriate only where a plaintiff has shown that in fact it has been injured,' or, put another way, 'that the mark lost value.'" *Fortinet, Inc. v. Fortanix, Inc.*, No. 20-cv-6900-MMC, 2022 WL 1128723, at *11 (N.D. Cal. Apr. 15, 2022) (quoting *Marketquest Grp., Inc. v. BIC*

³ At oral argument, it became apparent that one of Impossible's theories for why it was entitled to partial summary judgment as to punitive damages went to the merits of IX's underlying common-law unfair competition claim. While Impossible indicated in its notice of the motion that it intended to move for partial summary judgment as to IX's common-law unfair competition claim, *see* ECF No. 259, this was not included in the table of contents, and it was not readily apparent from the moving papers that Impossible sought summary judgment on the underlying claim. The Court finds that Impossible's failure to clearly identify this ground for summary judgment raises a notice issue and that consideration of Impossible's argument would be prejudicial. *Cf. Ortiz v. Lopez*, 688 F. Supp. 2d 1072, 1076 n.1 (E.D. Cal. 2010).

1 *Corp.*, 316 F. Supp. 3d 1234, 1301 (S.D. Cal. 2018)). A plaintiff seeking corrective advertising
 2 damages must demonstrate that (1) it enjoys an established goodwill and reputation, (2) it has
 3 suffered harm to that goodwill and reputation because of the defendant’s infringing activities, and
 4 (3) corrective advertising is appropriate to restore that harm. *Skydive Ariz., Inc. v. Quattrocchi*,
 5 673 F.3d 1105, 1113 (9th Cir. 2012). While the plaintiff “need not show a specific measure of
 6 harm,” it “must present non-speculative evidence that goodwill and reputation . . . was damaged in
 7 some way.” *Quia Corp. v. Mattel, Inc.*, No. 10-cv-1902-JF-HRL, 2011 WL 2749576, at *6
 8 (N.D. Cal. July 14, 2011); *see also Int’l Oddities v. Record*, No. 12-cv-3934-CAS, 2013 WL
 9 3864050, at *14 (C.D. Cal. July 22, 2013).

10 Impossible argues that Mr. Runyon’s deposition testimony—which is binding on IX—
 11 conclusively establishes that IX’s marks have not been harmed at all. *See* Pl.’s Mot. at 5–6.
 12 Impossible points out that Mr. Runyon was unable to state what the value of his business or marks
 13 were at any point in the last ten years and repeatedly confirmed that IX’s reputation “is” and has
 14 “always been very good” among its target “consumers, just everyday people.” *Id.* (quoting
 15 Runyon Dep. Tr. at 305:2–306:12). In this respect, Impossible seeks to analogize this case to *Wag*
 16 *Hotels, Inc. v. Wag Labs, Inc.*, No. 20-cv-1326-BLF, 2023 WL 3605977 (N.D. Cal. May 22,
 17 2023), where the plaintiff’s CFO testified that the plaintiff “ha[d] not done any particular analysis
 18 on” whether the defendant had done anything to impact the company’s financial performance, and
 19 the plaintiff’s CEO testified that no analysis had been done as to whether defendant’s alleged
 20 misconduct impacted the value of the plaintiff’s goodwill. *Id.* at *9. In *Wag Hotels*, the Court
 21 concluded that the defendant was entitled to summary judgment on the issue of corrective
 22 advertising damages because the plaintiff had “provided no evidence of any damage to the value
 23 of its mark.” *Id.* at *10.

24 In opposing the motion, IX first points to other portions of Mr. Runyon’s 30(b)(6)
 25 deposition testimony, where he testified to several specific instances of actual consumer
 26 confusion. For example, he stated that, at a festival, “approximately half a dozen people were
 27 confused” when he approached them, explaining that their association of his brand with
 28 Impossible caused them to be “cautious[]” in their dealings with him. Runyon Dep. Tr. at 285:4–

286:17. Mr. Runyon also stated that, on a separate occasion, upon seeing his IMPOSSIBLE t-shirt a customer asked him: “It’s not that Impossible meat company? You’re in the wrong place if do [sic] that.” *Id.* at 288:17–21. Mr. Runyon explained that the harm caused by this confusion has been that he has had to “counteract[customers’] impulse negative reaction[s],” and that this difficulty has been compounded by reduced search rankings on Google and has required IX to increase its advertising expenses. *Id.* at 311:4–18, 312:14–313:8.

While the Court agrees that Mr. Runyon’s testimony in isolation would be unlikely to create a genuine factual dispute as to harm to IX’s marks, IX also identifies portions of its expert reports describing IX’s performance and brand value. In his expert report, Dr. Palmatier opined that IX’s expenditures with respect to its IMPOSSIBLE brand “allowed [IX] to generate brand awareness and a unique brand identity,” Palmatier Rep. ¶ 24, further stating that “[a]ny negative or unwanted associations due to consumer confusion that are linked to the [IX’s] brand or other damage to [its] brand would typically require restorative marketing investments (e.g., corrective advertising) to rebuild [IX’s] brand equity.” *Id.* ¶ 6; *see also id.* ¶ X (“Impossible Foods’ sales and promotion of Impossible-branded clothing and cookbooks viewed by [IX’s] customers or potential customers would damage [IX’s] brand equity.”). In her expert report, Dr. Vanderhart showed that IX’s income decreased after the release of the Impossible Cookbook and Impossible Swag. Vanderhart Rep. Ex. C-2; *see also id.* ¶¶ 50–51.

The Court concludes that Mr. Runyon’s testimony, taken together with Dr. Palmatier and Dr. Vanderhart’s expert reports, is sufficiently nonspeculative for purposes of summary judgment. To the extent that Impossible argues that Mr. Runyon’s failure to provide a precise valuation of IX’s trademarks or profits bars corrective advertising damages as a matter of law, the Ninth Circuit has made it clear that a plaintiff is not required to “provide a specific mathematical formula.” *Skydive Ariz.*, 673 F.3d at 1112. Similarly, Mr. Runyon’s opinion that IX enjoys a positive reputation with its customers does not as a matter of law negate the other portions of his testimony in which he stated that customers falsely associated IX with Impossible and drew negative inferences against him because of that association. Although Impossible will be free to argue at trial that these portions of Mr. Runyon’s testimony are contradictory, it is for the jury—

1 not the Court at summary judgment—to make a final credibility determination, and the jury is
2 “entitled to . . . hear the full evidence” rather than “isolated sentences” from Mr. Runyon’s
3 deposition. *Snapp v. United Transp. Union*, 889 F.3d 1088, 1103 (9th Cir. 2018).

4 Relatedly, Impossible argues that, even if there is evidence of harm to IX’s reputation and
5 goodwill, IX has failed to show that such harm was caused by Impossible’s alleged infringing
6 conduct (i.e., the Impossible Cookbook and Impossible Swag), as opposed to Impossible’s
7 legitimate use of its IMPOSSIBLE (i.e., in connection with its line of plant-based meat
8 substitutes). Pl.’s Mot. at 13. In this respect, Impossible identifies portions of Dr. Palmatier’s
9 deposition testimony in which he testified that he did not “isolate the effect [of] Impossible Foods’
10 distribution of free clothing” and the Impossible Cookbook on IX’s marks. Henn Decl. Ex. I
11 (“Palmatier Dep. Tr.”) at 192:3–10. Impossible’s argument—which it styles as an objection that
12 IX has not sufficiently set forth evidence showing causation—amounts at bottom to an attack on
13 the weight of the evidence, which is not a ground for summary judgment.

14 While the Court agrees that a reasonable jury could infer from the record that any harm to
15 IX was caused by Impossible’s legitimate use of its marks, it is not for the Court to make this
16 determination at the summary judgment stage. This case is unlike *Wag Hotels*, where the Court
17 noted that the plaintiff solely relied upon evidence of consumer confusion and failed to present
18 any competent evidence that “this confusion resulted in damage to the value of its mark by
19 comparing its profits before and after the infringement.” *Wag Hotels*, 2023 WL 3605977, at *9.
20 Here, in contrast, IX “compare[d its] historical sales and profits before and after the infringement
21 and calculated[] lost profits that could be attributable to this confusion.” *Marketquest*,
22 316 F. Supp. 3d at 1301. “Although certainly there could be other explanations for this loss,” the
23 Court agrees with IX that “this is sufficient information to put the theory in front of the jury for
24 determination.” *Id.*

25 While the Court agrees that IX certainly faces an uphill battle at trial, the Court concludes
26 that a reasonable jury could find that IX experienced a financial decline following the release of
27 the Impossible Cookbook and Impossible Swag that was attributable to harm to IX’s goodwill and
28 reputation. Accordingly, Impossible’s request for partial summary judgment that IX is not entitled

1 to corrective advertising damages is DENIED.

2 **2. Reputational Damages**

3 Impossible also requests that the Court grant partial summary judgment that IX is not
4 entitled to reputational damages. Pl.'s Mot. at 17. Impossible argues that, because IX did not
5 provide a computation in its initial disclosures of such damages pursuant to Federal Rule of Civil
6 Procedure 26, *see* Henn Decl. Ex. S, dismissal of its demand for reputational damages is
7 appropriate under Rule 37(c)(1)(C). Pl.'s Mot. at 17. IX does not contest the point.

8 Rule 26 requires that a party provide a "computation of each category of damages claimed
9 by the disclosing party" in its initial disclosures. Fed. R. Civ. P. 26(b)(1)(A)(iii). The purpose of
10 the computation requirement is to apprise defendants of their potential exposure and to enable
11 defendants to make informed decisions as to settlement and discovery. *City & Cty. of San*
12 *Francisco v. Tutor-Saliba Corp.*, 218 F.R.D. 219, 221 (N.D. Cal. 2003). "Rule 37 'gives teeth' to
13 Rule 26's disclosure requirements by forbidding the use at trial of any information that is not
14 properly disclosed." *Goodman v. Staples the Off. Superstore, LLC*, 644 F.3d 817, 827 (9th Cir.
15 2011) (quoting *Yeti by Molly Ltd. v. Deckers Outdoor Corp.*, 259 F.3d 1101, 1106 (2001)).
16 "[W]here a party fails to disclose information required in Rule 26(a) and that failure is not
17 harmless, a party may not be permitted to use that evidence at trial." *Colombini v. Members of Bd.*
18 *of Dirs. of Empire Coll. Sch. of L.*, No. 97-cv-4500-CRB, 2001 WL 1006785, at *8 (N.D. Cal.
19 Aug. 17, 2001), *aff'd sub nom.*, *Colombini v. Members of Bd. of Dirs.*, 61 F. App'x 387 (9th Cir.
20 2003). This is based on the straightforward recognition that "[d]efendants are not required to
21 compute damages[because] Rule 26 requires plaintiffs to do so." *Villagomes v. Lab'y Corp. of*
22 *Am.*, 783 F. Supp. 2d 1121, 1129 (D. Nev. 2011).

23 There is no dispute that IX failed to comply with Rule 26's disclosure requirement with
24 respect to reputational damages: Its initial disclosure makes no reference to reputational damages.
25 *See* Henn Decl. Ex. S at 14 ("[IX] seeks disgorgement of profits under 15 U.S.C. § 1117(a), as
26 well as punitive and exemplary damages as the Court finds appropriate to deter any future willful
27 infringement."). The Court agrees with Impossible that IX's failure to provide any information
28 about the computation of reputational damages is prejudicial to Impossible because it deprives

Impossible of the opportunity to reasonably respond to the demand. Because it is “wholly unclear how [IX is] to determine the damages to . . . reputation” the Court agrees that “exclusion of this damages theory is warranted.” *Int’l Metaphysical Ministry, Inc. v. Wisdom of Heart Church*, No. 21-cv-8066-KAW, 2022 WL 19691043, at *6 (N.D. Cal. Dec. 19, 2022). Having determined that all such evidence would be excluded at trial, the Court finds that IX cannot present any evidence to show any disputed facts with respect to reputational damages. Accordingly, Impossible’s request for partial summary judgment that IX is not entitled to reputational damages is GRANTED.

3. Punitive Damages

Impossible requests that the Court grant partial summary judgment that IX is not entitled to punitive damages with respect to its common-law infringement claim. Impossible argues that IX cannot establish entitlement to punitive damages because it has failed to create a triable issue of fact that (1) IX is entitled to actual damages, (2) IX has superior common-law rights in California, and (3) Impossible acted with oppression, fraud, or malice. Pl.’s Mot. at 17–18. As described *supra*, the Court finds that IX has met its burden of raising a triable issue of fact as to actual damages; the Court also declines to consider Impossible’s merits-based argument that IX’s underlying common-law unfair competition claim fails because of the lack of notice to IX. Accordingly, the Court limits its analysis to Impossible’s third argument, to which IX responds that there is sufficient evidence for a reasonable jury to conclude that Impossible intentionally adopted IX’s trademark in conscious disregard of IX’s rights. Defs.’ Opp. at 23.

Under California law, a party may be awarded punitive damages only if “there is some evidence of fraud, malice, express or implied, or oppression.” *Spinks v. Equity Residential Briarwood Apartments*, 171 Cal. App. 4th 1004, 1052 (2009). Punitive damages must be proven by ‘clear and convincing’ evidence.” *Am. Airlines, Inc. v. Sheppard, Mullin, Richter & Hampton*, 96 Cal. App. 4th 1017, 1050 (2002) (quoting Cal. Civ. Code § 3294). “In the usual case, the question of whether the defendant’s conduct will support an award of punitive damages is for the trier of fact, since the degree of punishment depends on the peculiar circumstances of each case.” *Spinks*, 171 Cal. App. 4th at 1053; *see also Hannon Eng’g, Inc. v. Reim*, 126 Cal. App. 3d 415,

1 431 (1981).

2 The Court finds no good reason to diverge from the general principle that punitive
3 damages awards are a question for the trier of fact. A reasonable jury could find, for example, that
4 Impossible's alleged infringement of a much smaller competitor's intellectual property is
5 oppressive, fraudulent, or malicious. *See QS Wholesale, Inc. v. World Mktg., Inc.*, No. 12-cv-451,
6 2014 WL 12586120, at *4 (C.D. Cal. Jan. 7, 2014). Accordingly, Impossible's request for partial
7 summary judgment that IX is not entitled to punitive damages is DENIED.

8 **B. Affirmative Defenses**

9 **1. Laches**

10 IX contends that Impossible's Lanham Act and common-law unfair competition claims
11 challenging the IX Powders are barred by laches based on Impossible's "longstanding actual
12 and/or constructive knowledge of [IX's] use of IMPOSSIBLE with edible products." Answer
13 at 53. Impossible requests that the Court grant partial summary judgment that the claims are not
14 barred by laches because IX cannot prove the elements of the claim. Impossible supports this
15 argument with evidence showing that (1) Impossible asserted its claims two years after IX began
16 selling the IX Powders in 2022, and (2) there is no evidence of prejudice. Pl.'s Mot. at 20. IX
17 responds that it began selling krill oil under the IMPOSSIBLE brand in 2017, such that Impossible
18 delayed seven years in asserting its claims. Defs.' Opp. at 24.

19 "Laches is an equitable time limitation on a party's right to bring suit." *Jarrow Formulas,*
20 *Inc. v. Nutrition Now, Inc.*, 304 F.3d 829, 835 (9th Cir. 2002) (quoting *Boone v. Mech. Specialties*
21 *Co.*, 609 F.2d 956, 958 (9th Cir. 1979)). The doctrine is animated by the concern that "one who
22 seeks the help of a court of equity must not sleep on his rights." *Id.* (citation omitted). To prevail
23 on the affirmative defense of laches, a defendant must establish that (1) the plaintiff unreasonably
24 delayed in suing and (2) such delay is prejudicial to the defendant. *Miller v. Glenn Miller Prods.,*
25 *Inc.*, 454 F.3d 975, 997 (9th Cir. 2006).

26 Noting the "strong presumption against laches" in cases where a claim is brought within
27 four years of the date a plaintiff "knew (or should have known) of the allegedly infringing
28 conduct," Impossible argues that summary judgment is appropriate because it moved to assert its

claims two years after IX began selling the IX Powders in 2022. *Id.* at 20 (quoting *Eat Right Foods Ltd. v. Whole Foods Mkt., Inc.*, 880 F.3d 1109, 1115 (9th Cir. 2018)). “Determining whether a plaintiff delayed unreasonably consists of (1) assessing the length of the delay and then (2) determining whether the delay was reasonable.” *Kiva Health Brands LLC v. Kiva Brands Inc.*, 439 F. Supp. 3d 1185, 1191 (N.D. Cal. 2020). IX adduces no evidence that Impossible had actual or constructive notice of IX’s use of the IMPOSSIBLE mark in connection with its krill oil, so any delay by Impossible was presumptively reasonable. *See Reno Air Racing Ass’n. v. McCord*, 452 F.3d 1126, 1139 (9th Cir. 2006) (explaining that laches requires more than a “mere handful of limited sales . . . [with] no evidence of knowledge”).

The Court notes that, at oral argument, IX represented that there is evidence in the record that Impossible apparently monitored IX for inspiration around the time it began rebranding in the early 2010s. IX did not identify any evidence, however, that Impossible was still monitoring IX at the time that IX began offering krill oil, which it began selling years later. In any event, IX did not raise this argument in its opposition brief, so it is waived. *See In re Online DVD Rental Antitrust Litig.*, No. 09-cv-2029-PJH, 2011 WL 5883772, at *12 (N.D. Cal. Nov. 23, 2011) (explaining that, absent unusual circumstances, failure to respond to argument on merits “viewed as grounds for waiver or concession of the argument”).

IX having failed to adduce any evidence of unreasonable delay, the Court concludes that Impossible is entitled to partial summary judgment that its claims are not barred by laches. Moreover, the Court concludes that partial summary judgment is independently warranted because of IX’s failure to even suggest that any delay by Impossible in asserting its claims has been prejudicial. *See Adidas Am., Inc. v. Payless Shoesource, Inc.*, 546 F. Supp. 2d 1029, 1072 (D. Or. 2008) (granting summary for failure to show prejudice). Courts generally recognize two forms of prejudice in the context of laches: (1) expectations-based prejudice and (2) evidentiary prejudice. “‘Expectations’ based prejudice occurs when a defendant ‘took actions or suffered consequences that it would not have, had the plaintiff sued promptly.’ ‘Evidentiary prejudice includes such things as lost, stale, or degraded evidence, or witnesses whose memories have faded or who have died.’” *EEOC v. Timeless Invs., Inc.*, 734 F. Supp. 2d 1035, 1067 (E.D. Cal. 2010) (citation

omitted) (quoting *Grand Canyon Tr. v. Tucson Elec. Power Co.*, 391 F.3d 979, 988 (9th Cir. 2004)). There is no evidence that Impossible’s failure to bring suit in 2017 caused IX to act to its detriment or impaired its ability to defend itself in these proceedings. Indeed, IX practically conceded that it failed to meet its burden as to prejudice at oral argument. Accordingly, Impossible’s request for partial summary judgment as to laches is GRANTED.

2. Waiver

IX contends that Impossible’s trademark cancellation claims are barred by waiver based on Impossible’s “actual and constructive use of [IX’s] use and trademark of the IMPOSSIBLE-formative mark in relation to non-edible products since at least 2013.” Answer at 53. Impossible requests that the Court grant partial summary judgment that the claims are not barred by waiver because IX has not provided any evidence of an affirmative act by Impossible, as is required for an affirmative defense of waiver. Pl.’s Mot. at 20–21. IX’s only response—which is its sole response to Impossible’s motion as to each of IX’s remaining affirmative defenses—is that “Impossible Foods fails to carry its burden of production because it does not cite any evidence to negate an essential element of the defenses or show that [IX] lacks evidence to support them.” Defs.’ Opp. at 25.

IX’s position is untenable as a matter of law. Impossible provided the Court with IX’s full explanation of the evidence underlying the acquiescence defense (which overlaps significantly with waiver and estoppel), *see* Henn Decl. Ex. T, which is more than sufficient to “show that the nonmoving party does not have enough evidence of an essential element to carry its ultimate burden of persuasion at trial.” *Unicorn Energy AG v. Tesla Inc.*, 740 F. Supp. 3d 930, 940 (N.D. Cal. 2024); *see also Nissan*, 210 F.3d at 1102 (“[T]he nonmoving party does not have enough evidence of an essential element to carry its ultimate burden of persuasion at trial.”). IX’s non-response necessarily compels summary judgment in Impossible’s favor. The Court addresses each remaining affirmative defense solely for the sake of completeness.

Waiver is “the intentional relinquishment or abandonment of a known right.” *Lynch v. Cal. Coastal Com.*, 3 Cal. 5th 470, 475 (2017). For a court to find that a party has waived its rights, the court must find “an existing right, the waiving party’s knowledge of that right, and the

party’s ‘actual intention to relinquish the right.’” *Id.* (quoting *Bickel v. City of Piedmont*, 16 Cal. 4th 1040, 1053 (1997)). “Waiver always rests upon intent.” *Id.* (quoting *City of Ukiah v. Fones*, 64 Cal. 2d 104, 107 (1966)).

Because IX “has provided no evidence that [Impossible] knew of [its conduct], much less that it intentionally and knowingly abandoned any rights . . . because of such knowledge,” Impossible is entitled to partial summary judgment that its claims are not barred by waiver. *LL B Sheet 1, LLC v. Loskutoff*, 362 F. Supp. 3d 804, 823 (N.D. Cal. 2019). The Court accordingly GRANTS Impossible’s request for partial summary judgment as to waiver.

3. Acquiescence

IX contends that Impossible’s trademark cancellation claims are barred by the doctrine of acquiescence “based on [Impossible’s] active representation that it would not assert a right or claim against [IX] for their use of the IMPOSSIBLE-formative mark.” Answer at 53. Impossible requests that the Court grant partial summary judgment that the claims are not barred by acquiescence because IX has not provided any evidence of an active representation. Pl.’s Mot. at 21.

“To establish a claim for acquiescence, defendant must prove that plaintiff knew of facts giving it notice of its trademark infringement claim.” *Nat’l Grange of the Ord. of Patrons of Husbandry v. Cal. State Grange*, 115 F. Supp. 3d 1171, 1180 (E.D. Cal. 2015), *aff’d sub nom.*, *Nat’l Grange of Ord. of Patrons of Husbandry v. Cal. State Grange*, 715 F. App’x 747 (9th Cir. 2018). The defendant must demonstrate that “(1) the senior user actively represented that it would not assert a right or a claim; (2) the delay between the active representation and assertion of the right or claim was not excusable; and (3) the delay caused the defendant undue prejudice.” *Eat Right Foods*, 880 F.3d at 1121 (quoting *Seller Agency Council, Inc. v. Kennedy Ctr. for Real Est. Educ., Inc.*, 621 F.3d 981, 989 (9th Cir. 2010)).

To the extent that IX implies that Impossible’s purported delay or failure to act is tantamount to an active representation, that is simply not the case. *See, e.g., PetConnect Rescue, Inc. v. Salinas*, 656 F. Supp. 3d 1131, 1180 (S.D. Cal. 2023); *Tri-Union Seafoods LLC v. Otis McAllister, Inc.*, No. 17-cv-6646-JSW, 2020 WL 1550233, at *4 (N.D. Cal. Jan. 8, 2020)

1 (“Acquiescence requires ‘active consent’ while laches implies ‘merely passive consent.’” (quoting
2 *Tillamook Country Smoker, Inc. v. Tillamook Cty. Creamery Ass’n*, 311 F. Supp. 2d 1023, 1031
3 n.2 (D. Or. 2004), *aff’d*, 465 F.3d 1102 (9th Cir. 2006))). The Court accordingly GRANTS
4 Impossible’s request for partial summary judgment as to acquiescence.

5 **4. Estoppel**

6 IX contends that Impossible’s trademark cancellation claims are estopped “based on
7 [Impossible’s] actual knowledge that [IX was] using the IMPOSSIBLE formative-mark [sic] with
8 the non-edible products and services at issue in those claims.” Answer at 53. Impossible requests
9 that the Court grant partial summary judgment that the claims are not estopped because IX has not
10 adduced evidence as to any of the elements required for estoppel. Pl.’s Mot. at 21.

11 The elements of equitable estoppel are as follows: “(1) the party to be estopped must be
12 apprised of the facts; (2) he must intend that his conduct shall be acted upon, or must so act that
13 the party asserting the estoppel has a right to believe it was so intended; (3) the other party must be
14 ignorant of the true state of facts; and (4) he must rely upon the conduct to his injury.” *Schafer*
15 *v. City of Los Angeles*, 237 Cal. App. 4th 1250, 1261 (2015).

16 For the same reasons that the Court finds that Impossible is entitled to summary judgment
17 as to IX’s waiver and acquiescence affirmative defenses, the Court concludes that Impossible is
18 entitled to summary judgment as to IX’s estoppel affirmative defense. Namely, there is no
19 evidence that Impossible was apprised of IX’s alleged fraud or abandonment, and IX has not
20 adduced any evidence of injury. The Court accordingly GRANTS Impossible’s request for partial
21 summary judgment as to estoppel.

22 **5. Unclean Hands**

23 IX contends that Impossible’s trademark cancellation claims are barred by the doctrine of
24 unclean hands “based on [Impossible’s] inequitable conduct.” Answer at 53. Impossible requests
25 that the Court grant partial summary judgment that the claims are not barred by the doctrine of
26 unclean hands because there is no evidence that Impossible acted inequitably with respect to its
27 cancellation claims. Pl.’s Mot. at 21.

28 “The unclean hands doctrine ‘closes the doors of a court of equity to one tainted with

inequitable or bad faith relative to the matter in which he seeks relief.” *Jarrow Formulas*, 304 F.3d at 841 (quoting *Precision Instr. Mfg. Co. v. Auto. Maint. Mach. Co.*, 324 U.S. 806, 814 (1945)). To make out an unclean hands defense, a trademark defendant “must demonstrate that the plaintiff’s conduct is inequitable and that the conduct *relates to the subject matter of its claims*.” *Japan Telecom, Inc. v. Japan Telecom Am. Inc.*, 287 F.3d 866, 870 (9th Cir. 2002) (emphasis added) (quoting *Fuddrucker, Inc. v. Doc’s B.R. Others, Inc.*, 826 F.2d 837, 847 (9th Cir. 1987)).

IX fails to point to any evidence that Impossible acted inequitably with respect to the fraud and abandonment claims. More fundamentally, it is not even clear how Impossible could not have engaged in any inequitable conduct that relates to IX’s alleged fraudulent acts in registering its marks and then abandoning them. The Court accordingly GRANTS Impossible’s request for partial summary judgment as to unclean hands.

IV. IX’S MOTION

IX moves for partial summary judgment on Impossible’s claims for trademark infringement, unfair competition, and trademark cancellation. IX also requests summary adjudication that its marks have priority as to goods and services in what it styles the “Nutrition and Fitness Category.” Triable issues of fact preclude summary judgment for IX as to any of Impossible’s claims, so the Court denies IX’s motion in its entirety.

A. Lanham Act Claims

IX requests that the Court grant partial summary judgment as to Impossible’s Lanham Act claims for trademark infringement and unfair competition. IX argues that Impossible has failed to create a genuine dispute as to likelihood of confusion, urging that the IX Powders are so different from Impossible’s offerings that no reasonable jury could find in Impossible’s favor. Defs.’ Mot. at 7. Impossible responds that IX’s argument ascribes too much weight to this one factor and that it has met its burden of producing evidence showing disputed facts as to likelihood of confusion. Pl.’s Opp. at 11.

To prevail on a claim arising under the Lanham Act, a plaintiff must prove that (1) it has a protectible ownership interest in the mark and (2) the defendant’s use of the mark is likely to

confuse consumers. *Network Automation, Inc. v. Adv. Sys. Concepts*, 638 F.3d 1137, 1144 (9th Cir. 2011); *Dep't of Parks & Rec. v. Bazaar Del Mundo, Inc.*, 448 F.3d 1118, 1124 (9th Cir. 2006). The likelihood of confusion inquiry turns on whether a “reasonably prudent consumer in the marketplace is likely to be confused as to the origin of the good or service bearing one of the marks.” *Dreamwerks Prod. Grp., Inc. v. SKG Studio*, 142 F.3d 1127, 1129 (9th Cir. 1998).

Courts in the Ninth Circuit consider the following so-called *Sleekcraft* factors in evaluating likelihood of confusion:

1. strength of the mark;
2. proximity of the goods;
3. similarity of the marks;
4. evidence of actual confusion;
5. marketing channels used;
6. type of goods and the degree of care likely to be exercised by the purchaser;
7. defendant’s intent in selecting the mark; and
8. likelihood of expansion of the product lines.

AMF Inc. v. Sleekcraft Boats, 599 F.2d 341, 348–49 (9th Cir. 1979).

Application of the *Sleekcraft* factors is “fluid,” and the plaintiff “need not satisfy every factor, provided that strong showings are made with respect to some of them.” *Survivor Media, Inc. v. Survivor Prods.*, 406 F.3d 625, 631 (9th Cir. 2005). “‘Given the open-ended nature of this multi-prong inquiry’ summary judgment on likelihood of confusion grounds is ‘generally disfavored.’” *Roblox Corp. v. WowWee Grp. Ltd.*, No. 22-cv-4476-SI, 2024 WL 4051751, at *6 (N.D. Cal. Sept. 3, 2024) (quoting *Rearden LLC v. Rearden Comm., Inc.*, 683 F.3d 1190, 1210 (9th Cir. 2012)). IX argues that, applying certain *Sleekcraft* factors, there can be no likelihood of confusion as a matter of law; Impossible offers evidence of disputed facts on those and other factors.

1. Relatedness of Products and Evidence of Actual Confusion

IX dedicates a significant amount of its briefing to the argument that Impossible’s plant-based meat substitutes and the IX Powders are so dissimilar that there is no likelihood of confusion as a matter of law. Defs.’ Mot. at 7–9. IX argues that this dissimilarity, combined with the lack of evidence of actual consumer confusion in the record, entitles it to partial summary judgment. A reasonable jury could come out either way, and Impossible presents sufficient

1 evidence of disputed material facts.

2 “For related goods, the danger presented is that the public will mistakenly assume there is
3 an association between the producers of the related goods, though no such association exists.”
4 *Sleekcraft*, 599 F.2d at 350. In assessing relatedness, the Court considers whether the goods at
5 issue are (1) complementary, (2) sold to the same class of purchasers, or (3) similar in use and
6 function. *Reeves v. Gen. Nutrition Ctrs., Inc.*, No. 10-cv-1654-JAK, 2012 WL 13018362, at *4
7 (C.D. Cal. Apr. 2, 2012). IX makes much of Impossible’s corporate designee’s deposition
8 testimony that “nutritional supplements are not the same types of products as plant-based meat
9 products.” Washington Decl. Ex. BB (“Hatman Dep. Tr.”) at 298:2–5.

10 Ms. Hatman’s testimony certainly may imply that the goods are not particularly
11 complementary, but “the law does not demand complete identity of goods.” *His & Her Corp.*
12 *v. Shake-N-Go Fashion Inc.*, No. 11-cv-5323-CAS, 2015 WL 13604255, at *7 (C.D. Cal. Apr. 6,
13 2015). “[T]he concept of relatedness . . . does not mean that customers would necessarily
14 consider the products as interchangeable.” *Nimbus Data Sys., Inc. v. Nimble Storage, Inc.*,
15 No. 11-cv-5323-CAS, 2011 WL 13261995, at *3 (N.D. Cal. June 27, 2011). Although the Court
16 agrees that a reasonable jury could find that the goods belong to different sides of the spectrum of
17 edible food products, they do have some similarities, such as emphasizing nutrition. *Cf. San*
18 *Miguel Pure Foods Co. v. Ramar Int’l Corp.*, No. 11-cv-9747-RGK, 2012 WL 13227045, at *6
19 (C.D. Cal. Nov. 27, 2012) (“Courts have found a likelihood of confusion in seemingly unrelated
20 food items, such as . . . bakery products and frozen chicken.”).

21 There is also conflicting evidence as to whether the goods are directed to similar customer
22 bases. On one hand, IX persuasively demonstrates that the Parties’ offerings are directed to
23 entirely different constituencies, pointing out that Ms. Hatman testified that Impossible’s offerings
24 target consumers concerned with “the ethical or environmental consequences that may come with
25 eating animal meat,” Hatman Dep. Tr. at 169:9–16, while the IX Powders are directed to
26 consumers interesting in enhancing physical performance, Runyon Dep. Tr. at 347:3–18. On the
27 other hand, Impossible points to evidence showing that that other well-known companies sell both
28 types of products, *see* Declaration of Bruce Nelson (“Nelson Decl.”) Exs. A–L, supporting the

inference that consumers could expect meat substitutes and energy supplements to be sold by the same company. *Naterra Int’l, Inc. v. Bensalem*, 92 F.4th 1113, 1117 (Fed. Cir. 2024) (“[T]estimony that third-party companies sell both types of goods is pertinent to the relatedness of the goods.”).⁴

With regard to evidence of actual confusion, which Impossible concedes there is little, *see* Pl.’s Opp. at 16, “the absence of such evidence is not dispositive.” *Sunsauce Foods Indus. Corp. v. Son Fish Sauce USA Corp.*, No. 22-cv-8973-PCP, 2024 WL 4933346, at *6 (N.D. Cal. Dec. 2, 2024) (quoting *Off. Airline Guides, Inc. v. Goss*, 6 F.3d 1385, 1393 (9th Cir. 1993)); *see also Acad. of Mot. Picture Arts & Scis. v. Creative House Promotions, Inc.*, 944 F.2d 1446, 1456 (9th Cir. 1991). The paucity of evidence of actual confusion is not dispositive in this case. *See Gallo Winery*, 967 F.2d at 1292 (explaining that the absence of evidence of actual confusion “need not create an inference that there is no likelihood of confusion”). Indeed, the lack of actual evidence is hardly surprising given IX’s small number of customers. *See* Flemming Decl. Ex. X. A reasonable jury could find, however, that the “scant evidence of actual confusion in the record[]’ . . . favors [the] defendant.” *La Canada Ventures*, 2024 WL 3643082, at *3 (quoting *Survivor Media*, 406 F.3d at 633); *accord Top Brand LLC v. Cozy Comfort Co. LLC*, 143 F.4th 1349, 1366 (Fed. Cir. 2025).

2. Strength and Similarity of Marks

Impossible argues that there is evidence in the record from which a reasonable jury could determine that there is a likelihood of confusion, particularly with respect to its marks’ strength and the similarity of the marks. The Court agrees and accordingly finds that there is a triable factual dispute precluding partial summary judgment.

“The stronger a mark—meaning the more likely it is to be remembered and associated in the public mind with the mark’s owner—the greater the protection it is accorded by the trademark laws.” *Brookfield Commc’ns, Inc. v. W. Coast Ent. Corp.*, 174 F.3d 1036, 1058 (9th Cir. 1999).

⁴ IX objects to evidence of third parties offering both products on the ground that Impossible did not disclose it during discovery. Defs.’ Reply at 2–3. The objection is meritless, as this information is publicly available.

1 A mark's strength is evaluated along two axes: conceptual strength and commercial strength.
2 *GoTo.com, Inc. v. Walt Disney Co.*, 202 F.3d 1199, 1207 (9th Cir. 2000).

3 "To determine a mark's conceptual strength, we classify a mark along a spectrum of five
4 categories ranging from strongest to weakest: arbitrary, fanciful, suggestive, descriptive, and
5 generic. Arbitrary and fanciful marks, which employ words and phrases with no commonly
6 understood connection to the product," are the strongest. *JL Beverage Co. v. Jim Beam Brands*
7 *Co.*, 828 F.3d 1098, 1107 (9th Cir. 2016) (citation omitted). A reasonable jury could conclude
8 that Impossible's marks are arbitrary, i.e., "actual words with no connection to the product."
9 *Fortune Dynamic, Inc. v. Victoria's Secret Stores Brand Mgmt., Inc.*, 618 F.3d 1025, 1033
10 (9th Cir. 2010). Because the word "impossible" arguably does not describe or suggest any
11 specific qualities of Impossible's plant-based meat substitutes, a jury could reasonably conclude
12 that marks are conceptually strong and should be accorded significant protection. *See JL*
13 *Beverage Co.*, 828 F.3d at 1108.

14 Commercial strength "is based on 'actual marketplace recognition,' and thus 'advertising
15 expenditures can transform a suggestive mark into a strong mark.'" *Network Automation*,
16 638 F.3d at 1149 (quoting *Brookfield Commc'ns*, 174 F.3d at 1058). Impossible has adduced
17 evidence that it has used its marks extensively in connection with advertising and promoting its
18 plant-based offerings since 2016. *See, e.g.*, Declaration of H. Forrest Flemming ("Flemming
19 Decl.") Ex. F at 8, ECF No. 274-1. A reasonable jury could determine that IMPOSSIBLE's marks
20 command significant actual recognition in the marketplace.

21 IX does not dispute that Impossible's marks are strong, instead baldly asserting that this
22 factor "does not even merit attention" because the Parties' "product lines are so distinct that the
23 strength of the mark at issue is simply not relevant." Defs.' Mot. at 11. Not so. The Ninth Circuit
24 has endorsed a "sliding scale approach as to the weight that relatedness will carry dependent upon
25 the strength of the trademark holder's mark." *Entrepreneur Media*, 279 F.3d at 1148; *see also*
26 *Dermfx, Inc. v. Obagi Med. Prods., Inc.*, No. 15-cv-1999-JVS, 2017 WL 2684548, at *8
27 (C.D. Cal. Mar. 24, 2017) ("When the disputed mark is weak, the 'proximity' or 'relatedness'
28 factor carries less weight in the likelihood of confusion analysis." (quoting *Entrepreneur Media*,

279 F.3d at 1148)). A reasonable jury could find that this factor weighs in Impossible’s favor.

Similarity of marks “is ‘critical’ to any likelihood-of-confusion analysis because ‘[o]bviously, the greater the similarity between the two marks at issue, the greater the likelihood of confusion.’” *Yuga Labs*, 144 F.4th at 1169 (alteration in original) (quoting *GoTo.com*, 202 F.3d at 1205–06). The fact finder must consider the marks “as a whole, as they appear in the marketplace,” *E. & J. Gallo Winery v. Gallo Cattle Co.*, 967 F.2d 1280, 1291 (9th Cir. 1992), on three levels: sight, sound, and meaning. *See, e.g., Good Meat Project v. GOOD Meat, Inc.*, 716 F. Supp. 3d 783, 800 (N.D. Cal. 2024). As with the strength of Impossible’s marks, IX does not dispute the marks’ similarity.

Impossible points to the evidence of similarity between the marks—a fact finder could determine that they are “strikingly similar.” *Trader Joe’s Co. v. Trader Joe’s United*, 150 F.4th 1040, 1051 (9th Cir. 2025); *see also La Canada Ventures, Inc. v. MDalgorithms, Inc.*, No. 22-cv-7197-RS, 2024 WL 3643082, at *5 (N.D. Cal. Aug. 2, 2024) (“The common use of this dominant element tends to show similarity in the parties’ marks.” (quoting *Alpha Indus., Inc. v. Alpha Steel Tube & Shapes, Inc.*, 616 F.2d 440, 444 (9th Cir. 1980))). While IX’s marks include a strikethrough that is not present in Impossible’s mark, the Court concludes that a reasonable jury could conclude that this factor “weighs in [Impossible’s] favor as similarities in marks ‘weigh more heavily than differences.’” *Id.* (quoting *Alpha Indus.*, 616 F.2d at 444). Courts have routinely found that marks were identical in similar contexts. *See Brookfield Commc’ns*, 174 F.3d at 1055 (collecting cases). By virtue of being the same word, the marks also have the same sound and meaning. A reasonable jury could find that this factor weighs in Impossible’s favor.

3. Remaining Factors

The Parties dedicate some briefing to the remaining *Sleekcraft* factors. Based on its review of the remaining factors, the Court concludes that there are significant factual disputes that require fact finding, rendering partial summary judgment inappropriate.

a. Marketing Channel Convergence. “Just as visual, aural, and semantic similarities between marks increase the likelihood of confusion, so too do convergent marketing channels. In assessing marketing channel convergence, courts consider whether the

parties’ customer bases overlap and how the parties advertise and market their products.” *Pom Wonderful LLC v. Hubbard*, 775 F.3d 1118, 1130 (9th Cir. 2014) (citation omitted). This factor looks to whether consumers are likely to be confused by encountering the parties’ goods in similar contexts. *La Quinta Worldwide LLC v. Q.R.T.M., S.A. de C.V.*, 762 F.3d 867, 876–77 (9th Cir. 2014). Neither party dedicates much briefing to this factor. Impossible meekly argues the Court should find that this factor tilts in its favor because both Parties sell their goods on Amazon and use social media marketing. See Pl.’s Opp. at 15. Generally, little weight is accorded to “the shared use of . . . ubiquitous marketing channel[s].” *Lerner & Rowe PC v. Brown Engstrand & Shely LLC*, 119 F.4th 711, 726 (9th Cir. 2024), *cert. denied*, 145 S. Ct. 2732 (2025) (quoting *Network Automation*, 638 F.3d at 1151). The evidence presented by the Parties does not suggest much overlap between the Parties’ marketing channels, so “the trier of fact should determine what weight to afford it when considering the totality of the circumstances.” *Ironhawk Techs., Inc. v. Dropbox, Inc.*, 2 F.4th 1150, 1167 (9th Cir. 2021).

b. Purchasers’ Degree of Care. “In analyzing the degree of care that a consumer might exercise in purchasing the parties’ goods, the question is whether a ‘reasonably prudent consumer’ would take the time to distinguish between the two product lines.” *Survivor Media*, 406 F.3d at 634 (quoting *Brookfield Commc’ns*, 174 F.3d at 1060). The two primary instances in which courts have found that consumers are likely to exercise a greater degree of care—thereby making confusion less likely—is when the consumers themselves are particularly knowledgeable about the goods at issue or when the goods are expensive. See, e.g., *Network Automation*, 638 F.3d at 1152; *Brookfield Commc’ns*, 174 F.3d at 1060; *Monster, Inc. v. Dolby Lab’ys Licensing Corp.*, 920 F. Supp. 2d 1066, 1074 (N.D. Cal. 2013). There is evidence in the record that favors both parties. IX argues that by the very nature of Impossible’s offerings, its customers are likely to exercise a higher degree of care than the average consumer, since individuals interested in purchasing plant-based meat alternatives often do so for

health, environmental, or ethical reasons. Defs.’ Mot. at 11. This is certainly plausible, as consumers motivated by such considerations may be more likely to exercise a higher degree of discernment in making their purchases. At the same time, however, there is evidence that Impossible intends to target both vegetarian and non-vegetarian consumers. Henn Decl. Ex. E (“Krogius Dep. Tr.”) at 113:1–20. Impossible argues that the goods are inexpensive, analogizing them to grocery store foods that have been held to demand a lesser standard of care from consumers. Pl.’s Opp. at 16 (citing ECF No. 138-7 at 9–20); *see Gallo Winery*, 967 F.2d at 1293 (holding that this factor weighed toward confusion in the context of wine and cheese). But there is no evidence how the prices of the goods compare to similar offerings. Because neither party “offers any factual evidence to support its allegations about their respective customers[, t]here is therefore a genuine dispute as to this factor,” and it does not favor either party. *Sunsauce Foods*, 2024 WL 4933346, at *4.

c. Defendant’s Intent. “When the alleged infringer knowingly adopts a mark similar to another’s, reviewing courts presume that the defendant can accomplish his purpose: that is, that the public will be deceived.” *Sleekcraft*, 599 F.2d at 354. While “an intent to confuse consumers is not required for a finding of trademark infringement,” *Brookfield Commc’ns*, 174 F.3d at 1059, it can be “strong evidence of a likelihood of confusion,” *Entrepreneur Media*, 279 F.3d at 1148. IX conclusorily argues that it “did not seek to cause confusion between the marks at issue.” Defs.’ Mot. at 10. The Court accords this argument little weight. *Survivor Media*, 406 F.3d at 634 (“[A]bsence of malice is no defense to trademark infringement[]” (alterations in original) (internal citation omitted)). In any case, IX’s argument is inappropriate at the summary judgment stage, where the Court must draw all inferences in the non-moving party’s favor: “[A]lthough the relative weight of permissible and impermissible motives may emerge at trial, [courts] must be careful about untangling them at summary judgment, where we must draw all reasonable inferences in [the non-movant’s] favor.” *Yuga Labs*, 144 F.4th at 1173.

d. Likelihood of Expansion. “Inasmuch as a trademark owner is afforded greater protection against competing goods, a ‘strong possibility’ that either party may expand his business to compete with the other will weigh in favor of finding that the present use is infringing.” *Sleekcraft*, 599 F.2d at 354. The primary inquiry in evaluating this factor is to determine whether the existence of the allegedly infringing mark poses the possibility of hindering the trademark holder’s plans to expand its offerings. *Entrepreneur Media*, 279 F.3d at 1152. Impossible argues that this factor weighs in its favor because Mr. Runyon stated that IX has an interest in expanding its product line to include whey protein powder. *See* Runyon Dep. Tr. at 348:13–16, 349:16–19. In response, IX argues that, since whey is derived from animals, no reasonable jury could find that this expansion would compete with Impossible. But this argument is at bottom a request for the Court to weigh the evidence, which the Court declines to do here. In any event, the Court does not find this factor to be particularly important at this stage, since Impossible does not point to any other evidence suggesting a likelihood of expansion, and mere speculation by Mr. Runyon is not evidence. *See Paladin Assoc., Inc. v. Mont. Power Co.*, 328 F.3d 1145, 1161 (9th Cir. 2003).

Summary judgment is not appropriate because the evidence suggests that Impossible has a strong mark, that the Parties’ marks are similar, and that there is a genuine factual dispute whether the Parties’ goods are related. *See Top Brand*, 143 F.4th at 1365–66 (reviewing likelihood of confusion based on mark strength, mark similarity, and evidence of actual confusion); *Rearden*, 683 F.3d at 1209 (“A determination may rest on only those factors that are most pertinent to the particular case before the court[]”); *Lindy Pen Co. v. Bic Pen Corp.*, 796 F.2d 254, 257 (9th Cir. 1986) (reversing district court’s finding of no likelihood of confusion for similar marks, even where other six factors favored the defendant); *cf. Dreamwerks*, 142 F.3d at 1130 (“Three of the *Sleekcraft* factors are pivotal here: (1) arbitrariness of the mark; (2) similarity of sight, sound and meaning; and (3) relatedness of the goods.”). “[C]onflicting facts render it unclear whether a likelihood of confusion exists, [so] summary judgment is inappropriate.” *Ironhawk*, 2 F.4th at 1161–62. Accordingly, IX’s request for partial summary judgment as to Impossible’s Lanham

1 Act claims is DENIED.

2 **B. California Common Law Unfair Competition**

3 IX requests that the Court grant partial summary judgment as to Impossible's common-law
4 unfair competition claim. IX contends that it is entitled to summary judgment on Impossible's
5 common law unfair competition claim because Impossible has not sufficiently demonstrated that
6 IX intended to "pass off" the IX Accused Products as Impossible's. Defs.' Mot. at 12–13.
7 Impossible responds that its common-law unfair competition claim rises and falls with its Lanham
8 Act claims. Pl.'s Opp. at 17.

9 The "ultimate test" of a common-law unfair competition claim under California law is
10 "whether the public is likely to be deceived or confused by the similarity of the marks."
11 *Century 21 Real Estate Corp. v. Sandlin*, 846 F.2d 1175, 1178 (9th Cir. 1988) (quoting *New West*
12 *Corp. v. NYM Co. of Cal.*, 595 F.2d 1194, 1201 (9th Cir. 1979)); *see also Glydways, Inc. v. Glyd,*
13 *Inc.*, No. 23-cv-203-EJD, 2025 WL 2988642, at *4 (N.D. Cal. Oct. 23, 2025); *Ingrid & Isabel,*
14 *LLC v. Baby Be Mine, LLC*, 70 F. Supp. 3d 1105, 1119 (N.D. Cal. 2014). Unfair competition
15 claims "are subject to the same test" whether they be brought under the Lanham Act or the
16 common law, and "the critical determination is 'whether an alleged trademark infringer's use of a
17 mark creates a likelihood that the consuming public will be confused as to who makes what
18 product.'" *Jada Toys, Inc. v. Mattel, Inc.*, 518 F.3d 628, 632 (9th Cir. 2008) (quoting *Brother*
19 *Recs., Inc. v. Jardine*, 318 F.3d 900, 908 (9th Cir. 2003)).

20 To the extent that IX argues that a common-law claim for unfair competition is distinct
21 from a claim under the Lanham Act in that it requires a plaintiff to separately prove "passing off,"
22 IX is mistaken. The case that it cites for this proposition states in full that unfair competition must
23 be proven by "acts *analogous* to 'passing off,' such as the sale of *confusingly similar* products."
24 *Southland Sod Farms v. Stover Seed Co.*, 108 F.3d 1134, 1147 (9th Cir. 1997) (emphasis added).
25 The Ninth Circuit "has consistently held that state common law claims of unfair competition . . .
26 are 'substantially congruent' to claims made under the Lanham Act." *Cleary v. News Corp.*,
27 30 F.3d 1255, 1263 (9th Cir. 1994).

28 IX also appears to argue that Impossible's common-law unfair competition claim requires

1 it to separately prove a “competitive injury.” Defs.’ Mot. at 15–16. IX’s argument rests on an
 2 additional misapprehension of the law. Under California law, if there is a likelihood of confusion,
 3 then “injury has occurred.” *Ball v. Am. Trial Laws. Ass’n*, 14 Cal. App. 3d 289, 304 (1971).
 4 Impossible’s common-law unfair competition claim rises and falls with its Lanham Act claims, so
 5 the Court DENIES IX’s request for partial summary judgment as to Impossible’s common-law
 6 unfair competition claim.

7 **C. Procurement by Fraud**

8 IX requests that the Court grant partial summary judgment as to Impossible’s claim for
 9 cancellation of the Challenged Marks for fraud on the PTO. IX focuses its motion not on the
 10 merits of the claim but instead argues that it is entitled to summary judgment because
 11 (1) Impossible lacks standing to assert its claim or, in the alternative, (2) Impossible’s claim is
 12 moot. Defs.’ Mot. at 16. Impossible responds that it has standing under 15 U.S.C. § 1064(c)
 13 based on IX’s wielding of the Challenged Marks against Impossible and that IX’s amendments to
 14 certain of its marks do not moot Impossible’s claim. Pl.’s Opp. at 8.

15 **1. Standing**

16 IX argues that Impossible lacks Article III standing to pursue its claim because 15 U.S.C.
 17 § 1119 authorizes cancellation of a trademark registration only when the claimant is also asserting
 18 an infringement claim against that same registration. Defs.’ Mot. at 17–18. According to IX,
 19 section 1119 is “a strictly remedial measure imposed to address trademark infringement under the
 20 Lanham Act, not a standalone claim to be freely asserted against another party’s registered marks
 21 absent infringement.” *Id.* at 18. While the Court agrees that section 1119 does not create a
 22 freestanding private cause of action for any party to seek cancellation of a trademark registration,
 23 Impossible plainly has standing to assert its claim for cancellation under 15 U.S.C. § 1064(c).

24 A party seeking trademark cancellation for fraud on the PTO pursuant to 15 U.S.C.
 25 §§ 1064(c), 1119 must show “a false representation regarding a material fact, the registrant’s
 26 knowledge or belief that the representation is false, the intent to induce reliance upon the
 27 misrepresentation, and reasonable reliance thereon, and damages.” *Hokto Kinoko Co. v. Concord*
 28 *Farms, Inc.*, 810 F. Supp. 2d 1013, 1041 (C.D. Cal. 2011) (citations omitted), *aff’d*, 738 F.3d 1085

(9th Cir. 2013). Cancellation under sections 1064(c) and 1119 may be “sought if there is already an ongoing action that involves a registered mark.” *Airs Aromatics, LLC v. Victoria’s Secret Stores Brand Mgmt.*, 744 F.3d 595, 599 (9th Cir. 2014).

A party has standing to pursue cancellation so long as the party believes that it “is or will be damaged by the registration of the mark.” *Star-Kist Foods, Inc. v. P.J. Rhodes & Co.*, 735 F.2d 346, 348 (9th Cir. 1984) (emphasis omitted) (quoting 15 U.S.C. § 1064); *see also Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 1305 (Fed. Cir. 2020). This is a low bar and “requires only” that the party show a “real interest” in the proceeding. *Star-Kist Foods*, 735 F.2d at 349; *see also Blue Bottle Coffee, LLC v. Liao*, No. 21-cv-6083-CRB, 2024 WL 2061259, at *8 (N.D. Cal. May 7, 2024) (“All that is needed is a real interest in the outcome of the proceeding beyond the general public.”). The Court finds that Impossible has satisfied its burden by demonstrating a particularized, concrete injury by IX’s wielding of the Challenged Marks. *See Hokto Kinoko*, 738 F.3d at 1097. Had the Court granted partial summary judgment for IX as to Impossible’s Lanham Act claims, this result might have been different.

2. Mootness

IX argues in the alternative that, even if Impossible has standing to pursue its claim for cancellation of the Challenged Marks, “there is no remedy for the Court to provide . . . because Impossible LLC has already amended its registrations to remove the disputed goods at issue.” Defs.’ Mot. at 19. IX argues that, because it amended some of its registrations to remove some of the goods from Class 25, there is no live case or controversy between the parties as to Impossible’s cancellation claim.

The sole case that IX cites for its argument is *Already, LLC v. Nike, Inc.*, 568 U.S. 85 (2013). The case has nothing to do with fraud, merely confirming that there is no Article III case or controversy where a plaintiff dismisses its infringement claims with prejudice and enters a covenant not to sue. *Id.* at 93. Moreover, courts have rejected similar arguments that such post-hoc partial amendments somehow moot cancellation claims. *See, e.g., Sunsauce Foods*, 2024 WL 4933346, at *10 (“Correcting an overstatement is not enough to rectify fraud.”); *One True Vine, LLC v. Wine Grp. LLC*, No. 09-cv-1328-MHP, 2009 WL 3707512, at *3 (N.D. Cal. Nov. 4, 2009)

1 (“[P]laintiff cannot nullify a claim that it procured its trademark through fraud on the USPTO by
2 now amending its trademark registration.”).

3 In any case, as Impossible notes, IX has only deleted a few apparel goods from within
4 Class 25 in the Challenged Marks that it has now amended. There is no dispute that the Court
5 may cancel the entirety of Class 25 in those registrations. A “trademark cancellation claim is
6 equitable in nature,” meaning that it is for the Court to determine whether and to what extent IX’s
7 marks must be cancelled for fraud. *Amarte USA Holdings, Inc. v. Kendo Holdings Inc.*, No. 22-
8 cv-8958-CRB, 2024 WL 4093910, at *13 (N.D. Cal. Sept. 4, 2024). Accordingly, the Court
9 DENIES IX’s request for partial summary judgment as to Impossible’s fraud claims.

10 **D. Abandonment**

11 IX requests that the Court grant partial summary judgment as to Impossible’s claim for
12 cancellation of the Challenged Marks for abandonment. IX argues that it is entitled to judgment as
13 a matter of law because the evidence indisputably shows that it has continuously used its marks
14 without an attempt to abandon them. Defs.’ Mot. at 18. Impossible responds that no such
15 evidence of continuous use exists. Pl.’s Opp. at 24.

16 The Lanham Act sets forth the conditions under which a trademark is subject to
17 cancellation for abandonment: “When its use has been discontinued with intent not to resume
18 such use. Intent not to resume may be inferred from circumstances. Nonuse for 3 consecutive
19 years shall be prima facie evidence of abandonment. ‘Use’ of a mark means the bona fide use of
20 such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.”
21 15 U.S.C. § 1127. “Because abandonment of a trademark is ‘in the nature of forfeiture, [it] must
22 be strictly proved.’” *Marketquest*, 316 F. Supp. 3d at 1281 (alteration in original) (quoting
23 *FreecycleSunnyvale v. Freecycle Network*, 626 F.3d 509, 515 (9th Cir. 2010)). A party makes out
24 a prima facie case of non-use by demonstrating that a mark has not been used for three
25 consecutive years. *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1087 (Fed. Cir.
26 2000).

27 IX argues that it is entitled to partial summary judgment as to abandonment because “the
28 undisputed material facts show [that it] has consistently prepared and sold apparel products

bearing the challenged marks, including within the last three years,” urging that even a single bona fide use of a mark is sufficient to defeat cancellation for abandonment. Defs.’ Mot. at 21. IX’s argument fails because the record evidence simply does not reflect what IX claims it does. In support of its motion for partial summary judgment, IX identifies a 2011 blog post by Mr. Runyon announcing the sale of t-shirts, a 2023 “merch drop” of hoodies, and a portion of Mr. Runyon’s 30(b)(6) deposition testimony in which he states that t-shirts are available for purchase on his website. *See* Washington Decl. Exs. G, N; Runyon Dep. Tr. at 145:5–9 (“Q. Can you buy a T-shirt through impossiblefitness.com? A. You can see a T-shirt, you can click on it, and you can buy it.”). IX apparently contends that evidence that it offered for sale disparate products in 2011, 2023, and at the time of Mr. Runyon’s deposition in 2025—without even identifying which of the Challenged Marks were featured on the apparel—forecloses Impossible’s abandonment claim. The argument borders on the offensive.

As a preliminary matter, Mr. Runyon has conceded that IX never offered many of the goods covered by the relevant marks. *See, e.g.*, Runyon Dep. Tr. at 131:2–3; 133:11–16; 133:18–134:4; 166:17–169:3; 201:4–202:8. The record similarly contains no evidence of use of the marks in connection with any of the other goods and services listed in the registrations for at least three years, triggering the presumption of non-use. Flemming Decl. Ex. H. There is even a factual dispute as to whether the products Mr. Runyon testified were on sale at the time of his deposition were actually available for purchase on his website. *See* Flemming Decl. Ex. Z (showing no menu items for shop or apparel), Ex. AA. At bottom, even if the Court were to credit that IX was using the marks in 2011, 2023, and 2025, IX has not met its moving burden and is not entitled to partial summary judgment. Accordingly, the Court DENIES IX’s request for partial summary judgment as to Impossible’s abandonment claims.

E. Priority

IX argues that it is entitled to summary adjudication of priority of use of the IMPOSSIBLE-formative marks” in a category that it terms the “Diet and Nutrition Category,” which includes “fitness, health, recipes, cookbooks, and nutrition advisory services.” Defs.’ Mot. at 22. According to IX, it is entitled to priority because (1) IX has continuously used

1 IMPOSSIBLE-formative marks in connection with the Diet and Nutrition Category since 2012;
 2 (2) IX has engaged in substantial non-commercial advertising and promotional activity to support
 3 its offerings; and (3) Impossible's use of the IMPOSSIBLE-formative marks in the Diet and
 4 Nutrition Category occurred more than eight years after IX's first use. *See id.* Impossible
 5 responds as a threshold matter that IX is not entitled to summary adjudication of priority of use
 6 with respect to this nebulously defined category, noting that the Impossible Accused Products
 7 represent a narrow set of goods and services, i.e., cookbooks, recipes, apparel, and philanthropy.
 8 Pl.'s Opp. at 22. Impossible further argues that IX fails to tie its evidence to any particular mark
 9 and cannot prove prior and continuous use. *See id.* at 22–24.

10 “It is axiomatic in trademark law that the standard test of ownership is priority of use,”
 11 such that “the party claiming ownership must have been the first to actually use the mark in the
 12 sale of goods or services.” *Sarieddine v. Alien Visions E-Juice, Inc.*, No. 18-cv-3658-PA,
 13 2019 WL 1966661, at *4 (C.D. Cal. Apr. 12, 2019) (quoting *Rearden*, 683 F.3d at 1202–03). To
 14 establish priority, the party must have been the first to actually use the mark in the sale of the
 15 relevant goods or services. *See Brookfield Commc'ns*, 174 F.3d at 1051 (“The Lanham Act grants
 16 trademark protection only to marks that are used to identify and to distinguish goods or services in
 17 commerce—which typically occurs when a mark is used in conjunction with the actual sale of
 18 goods or services.”).

19 IX appears to take the position that it is entitled to priority in this broad category of goods
 20 and services based on its introduction of two services in 2012. First, in February 2012, IX
 21 published the “Impossible TRI Triathlon Guide” (“Impossible TRI”), which includes an associated
 22 cookbook and nutrition guide and features IMPOSSIBLE-formative marks. Washington Decl.
 23 Exs. F, XX at 22–23. Second, in September 2012, IX published “Impossible Abs,” a health and
 24 fitness program that includes food, nutrition, and recipe sections, which it marketed to its
 25 customers. Washington Decl. Exs. H, AAA, BBB, XX at 22–23. These offerings, however, do
 26 not map neatly onto IX's defined Diet and Fitness category, which comprises fitness, health,
 27 recipes, cookbooks, and nutrition advisory services. For example, Mr. Runyon testified that IX
 28 does not offer any nutrition advisory services. Runyon Dep. Tr. at 61:22–62:1. He further

1 explained that IX's offerings in the fitness category are limited to online exercise programs and a
2 physical fitness blog. *Id.* at 113:1–17. Finally, regarding cookbooks, Mr. Runyon explained that
3 IX has not actually published any cookbook: IX apparently appears to be referencing downloads
4 of recipes from its website or from third-party apps. *Id.* at 63:15–19.

5 Apart from the apparent discrepancy between IX's actual offerings and the breadth of
6 goods and services for which it claims priority, it is also unclear to the Court at this stage whether
7 there is evidence in the record establishing continuous use. "A mark is deemed to be used in
8 commerce on goods when: (A) it is placed in any manner on the goods or their containers or the
9 displays associated therewith or on the tags or labels affixed thereto . . . and (B) the goods are sold
10 or transported in commerce." *Macy's Inc. v. Strategic Marks, LLC*, No. 11-cv-6198-EMC,
11 2016 WL 374147, at *6 (N.D. Cal. Feb. 1, 2016) (quoting 15 U.S.C. § 1127). "In determining
12 whether the two prongs of the 'use in commerce' test have been satisfied, we have generally
13 followed a 'totality of the circumstances' approach." *Rearden*, 683 F.3d at 1205. It is not at all
14 clear that IX has demonstrated continuous use in commerce with respect to any of the marks or
15 categories. While IX cites sales revenue from third-party affiliates, it has not shown that any of
16 those offerings bear an IMPOSSIBLE-formative mark (let alone identified which one). *See*
17 *Brookfield Commc'ns*, 174 F.3d at 1052 (explaining that use in commerce must "identify or
18 distinguish the marked goods in an appropriate segment of the public mind as those of the adopter
19 of the mark").

20 IX has not met its initial burden. Accordingly, the Court DENIES IX's request for
21 summary adjudication of priority.

22 **V. ORDER**

23 For the foregoing reasons, IT IS HEREBY ORDERED that:

24 (1) Impossible's motion for partial summary judgment is GRANTED as to IX's third
25 affirmative defense (laches), fourth affirmative defense (waiver), fifth affirmative
26 defense (acquiescence), sixth affirmative defense (estoppel), and tenth affirmative
27 defense (unclean hands).

28 (2) Impossible's motion for partial summary judgment is GRANTED as to IX's demand

1 for reputational damages.

2 (3) Impossible's motion for partial summary judgment is DENIED as to IX's demands for
3 corrective advertising damages and exemplary damages.

4 (4) IX's motion for partial summary judgment is DENIED.

5 (5) This order terminates ECF No. 259 and ECF No. 262.

6
7 Dated: November 3, 2025

8 
9 BETH LABSON FREEMAN
United States District Judge

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United States District Court
Northern District of California